REMARKS

I.   Status of the Claims:

Claims 1-36 are currently pending.

By this Amendment, claim 36 has been amended. No new matter has been introduced by this Amendment.

Upon entry of this Amendment, claims 1-36 would be pending.

II.   Non-Statutory Double Patenting Rejection

Claims 1-36 have been rejected under the judicially created non-statutory double patenting rejection. The Office Action alleges the following: (1) Claims 1-26 of Patent 6,678,516 contain each and every limitation of claims 1-36 of the instant application, and as such reject the instant application; and (2) Claims 1-43 of application no. 09/860,605 contain each and every limitation of claims 1-36 of the instant application, and as such, reject the instant application. Applicants respectfully traverse the rejection.

Applicants respectfully submit that the Office Action has not established a prima facie case of non-statutory double patenting. Specifically, the Office Action does not address with reasonable particularity the basis for this rejection. First, the Office Action does not appear to take into account that the present application is the **earlier** filed application and a terminal disclaimer was filed in U.S. Patent No. 6,678,516. Second, as best understood, the Office Action seems to base this rejection solely on domination, which is improper. See MPEP §804. Third, the Office Action is simply conclusory and does not make clear in the rejection: (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the

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art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent. <u>See</u> MPEP §804 (II)(B)(1). Finally, in the Office Action, it is unclear as to the applicability of the case law cited in paragraph 6 on page 3, such as the description of <u>In re Longi</u>, as to the present application which is the earlier filed application.

Accordingly, reconsideration and withdrawal of the rejection of these claims are respectfully requested.

III.   Objection of Claims 6-9

Claims 6-9 are objected as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, claim 5 recites "one of", which all of the service category, a service description, and a requested view point are not needed. As such claims 6-9 are rendered indefinite since they rely on limitations which are not necessarily required as part of the claim. Applicants respectfully disagree.

Although claim 5 covers situations where the information may be service category, a service description and/or a requested viewpoint, dependent claims 6-7 cover a <u>species</u> of claim 5 where the information comprises at least the service category and claims 8-9 cover a <u>species</u> of claim 5 where the information comprises at least the requested view point. In other words, the Office Action makes clear that claim 5 is broader than dependent claims 6-9. Thus, claims 6-9 further limits the subject matter of the prior claim 5, and are in proper dependent form.

IV.   Rejections under Sections §102 and §103

Claims 1-18, 21-25, 31-32, and 34 are rejected under 35 U.S.C. §102(e) as being

anticipated by Doi et al. (US 2001/0014911, hereinafter Doi). Claims 19, 26-28 and 30 are

rejected under 35 U.S.C. §103(a) as being unpatentable over Doi. Claim 20 is rejected under 35

U.S.C. §103(a) as being unpatentable over Doi in view of Rajchel et al. (USPN 6,496,931,

hereinafter Rajchel). Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over

Doi in view of Carothers et al. (US 2002/0069117, hereinafter Carothers). Claim 29 is rejected

under 35 U.S.C. §103(a) as being unpatentable over Doi in view of Owen et al. (USPN

6,611,501, hereinafter Owen). Applicants respectfully disagree with the rejections for the

following reasons.

1.   Claim 1:

Independent claim 1 is directed to a method involving recognizing one or more

service opportunities of a service operator on a user device operated by a user; determining a

privacy level at which communications is conducted with the service operator; and conducting

the communications with the service operator at the privacy level, wherein the recognizing

occurs before the determining and the conducting.

As to the claimed recognizing feature, the Examiner asserts that:

> Applicant will appreciate that before any communication between the
> mobile device and the service providing servers, a session must be set up
> between the wireless device and the wireless gateway. Although Doi does
> not specifically discloses this step, it is an inherent feature to the system,
> since there is no other way that the mobile device can access the service
> providing servers without the use of the wireless gateway. Therefore
> before any data is sent to the servers 21, 22, the mobile device recognizes
> the wireless gateway and sets up a communication session in order to
> access the servers.

Applicants respectfully disagree with the Examiner's inherency argument and interpretation of the interaction with the wireless gateway as teaching the claimed recognizing, particularly when the claim is read as a whole.

As best understood, the Examiner again appears to rely upon "access points" (i.e., wireless gateway) of the communication network infrastructure itself as the claimed service opportunit(ies) and not the services offered by the location dependent service provider. See Office Action, page 2. As is well understood, a wireless gateway simply interconnects a wireless network and another network, in this case, for example, a cellular network and the Internet. See Doi, [0031] and Figs. 1 and 11. The reliance on the wireless gateway of Doi is inconsistent with the Examiner's reading of Doi (e.g., Figs. 11-12, p.6, ¶67-73) on the remaining claimed elements, e.g., the determining and the conducting, which recite the same service operator. Specifically, in Doi, the service operator of the wireless gateway (as relied upon by the Examiner) simply appears to be the communication network operator, not the location dependent service provider. Such an interpretation would also be contrary to the claimed privacy arrangement since the operator of the "access point" actually receives the User ID. Thus, Doi does not disclose or suggest the claimed recognizing one or more service opportunities of a service operator and, accordingly, the claimed determining and conducting. The Office Action does not address with reasonable particularity who or what is the "service provider" as recited with respect to the claimed recognizing, determining and conducting operations.

Further, Doi shows a mobile terminal 10 capable of communication with a location dependent service provider, across a wireless network 18, wireless gateway 19 and Internet 20. The wireless gateway 19 provides a user ID randomizer which can conceal the User ID (of the mobile terminal) or replace the User ID with a temporary ID or ID of the gateway

when passing communications from the mobile terminal 10 to the location dependent service

provider, across the Internet. In operation, the mobile terminal sends a service request to the

already known location dependent service provider (and its services) across the wireless network

18, gateway 19 and Internet 20. Thus, the mobile terminal 10 does not perform any recognizing

one or more service opportunities of the location dependent service provider.

In view of the foregoing, claim 1 and the claims dependent therefrom are

patentably distinguishable over the cited references.

2.   Claim 34:

Independent claim 34 is directed to a method involving recognizing one or more

service opportunities of a service operator on a user device operated by a user; determining a

privacy level at which communications is conducted with the service operator relating to the one

or more service opportunities on the user device; determining a profile access level on the user

device; transmitting the profile access level to the service operator; and enabling the service

operator to obtain a subset of profile information of the user from the profile operator according

to the profile access level, wherein the recognizing occurs before the determining a privacy level,

the determining a profile access level, the transmitting and the enabling.

For similar reasons as discussed above for claim 1, Doi does not disclose or

suggest the claimed recognizing and determining.

Further, Doi does not disclose or suggest transmitting the profile access level to

the service operator, and enabling the service operator to obtain a subset of profile information of

the user from the profile operator according to the profile access level. For example, Figs. 2 and

3 of Doi, as relied upon by the Examiner, simply show a dynamic user profile maintained by

mobile terminal and a schematic diagram of a processing flow of providing a location dependent

service, respectively. As shown in Fig. 3 of Doi, the mobile terminal sends a service request along with the dynamic user profile to the location dependent service providing server, across a wireless gateway 19. Accordingly, Doi appears to be silent as to any profile operator, any transmission of a profile access level to the service operator, and any capability which enables the service operator to obtain a subset of profile information of the user from the profile operator according to the profile access level. The Office Action does not address with reasonable particularity the above noted deficiencies in the Doi teachings, including for example who or what is the profile operator and the service operator (which is different than the profile operator). See Office Action, page 32 (stating "Claim 34 is rejected for similar reasons as stated above).

In view of the foregoing, independent claim 34 is also patentably distinguishable over the cited references.

3.   Dependent Claim 36:

Claim 36, as amended, further recites that the user device controls what information is sent from the device according to the privacy level.

On the contrary, the Examiner's assertion that the user controls what information the service provider "receives" does not address control over what information (e.g., static profile, dynamic profile) is "sent from" the device, as claimed. As described in Doi, the wireless gateway 19 receives User ID, static profile and dynamic profile and selectively provides this information to the servers based on the communication control information table. See Doi, paras [0062]-[0063]. Accordingly, Doi also does not disclose or suggest that the user device controls what information is sent from the device according to the privacy level.

Thus, claim 36 is further distinguishable over the cited references.

4.   Dependent Claims 4 and 5:

Dependent claim 4 further recites wherein the recognizing comprises anonymously obtaining information relating to the one or more service opportunities.

The Examiner asserts that this feature is taught by Doi in paragraph [0036]. This paragraph however simply describes updating the dynamic user profile memory 16. It is unclear how the update of such information is part of the claimed recognizing operation, particularly in view of the Examiner's assertion concerning the wireless gateway. The Office Action does not address this claimed features with reasonable particularity. Accordingly, claim 4 is patentably distinguishable over the cited reference.

Dependent claim 5, which depends from claim 4, further recites wherein the information relating to the one or more service opportunities comprises one of a service category, a service description and a requested viewpoint.

Although Doi describes various types of services, it is silent as to such information being anonymously obtained by the terminal as part of the recognizing operation. As described above, the mobile terminal as configured appears to be already aware of the various services since the terminal is the originator or initiator of the service requests. The Office Action does not address this claimed feature with reasonable particularity, particularly in view of the Examiner's assertion as to the claimed recognizing feature. Accordingly, claim 5 is patentably distinguishable over the cited reference.

5.   Dependent Claim 27:

Claim 27 further recites tracking user activity on the user device, wherein the profile information of the user is updated based on the tracked user activity.

The Examiner asserts that one of ordinary skill in the art would modify Doi to update the profile information in order to track users using the system as well as for logging and security systems, which is well known as being under constant attacks from hackers. Applicants respectfully disagree. One of ordinary skill in the art would not look to the use of tracking cookies (e.g., used by websites and advertisers) as noted by the Examiner to modify Doi in the manner suggested by the Examiner on page 10 of the Office Action. The use of tracking cookies clearly is contrary to the privacy aspects of Doi. Further, the Examiner's motivation rationale is clearly not objective or properly tied to the alleged well know tracking cookies. On the one hand, the Examiner is relying on tracking cookies which run counter to privacy, but on the other hand rely on security and supposed attack by hackers for the motivational basis. It is apparent that the Examiner is relying on impermissible hindsight. Accordingly, claim 27 is further distingushablve over the cited reference.

6.   Dependent Claim 30:

Claim 30 further recites the user device and the service operator communicate across a personal area network.

While Bluetooth devices may be capable of communicating in a PAN, the relevant aspects of DOI reside in the wireless gateway 19 which clearly does not involve a personal area network. The Office Action does not properly address the claim as a whole and provides no objective evidence to support implementation or modification of DOI where the user device and the service operator communicate across a PAN and perform the claimed invention. That is, the Examiner's motivational basis simply calls for modifying the terminal in Doi to perform PAN, without addressing how the various aspect of DOI being relied upon to read on

the claimed invention would be modified or implemented in a PAN environment. Accordingly, claim 30 is patentably distinguishable over the cited reference.

7.   Dependent Claim 29:

Claim 29 further recites that the service opportunities recognized by the user are dynamically changed by the service provider according to profile information of the user.

As acknowledged by the Examiner, Doi does not disclose or suggest the above noted feature. The Examiner relies on Owen as allegedly teaching this feature. However, Owen as relied upon by the Examiner relates to a connection management system in which user agents may negotiate, such as based on a user profile, to establish a mutually acceptable connection configuration between two users. Owen has nothing whatsoever to do with an arrangement between a user and a service provider as claimed, and moreover it is unclear what if any relevance Owen has with Doi, particularly as to those aspect being relied upon as allegedly reading upon the claimed inventions. It is apparent that the Examiner is arbitrarily picking and choosing from the references to read on the claimed invention.

Accordingly, claim 29 is patentably distinguishable over the cited reference.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request

reconsideration and withdrawal of the rejection of claims and allowance of this application.
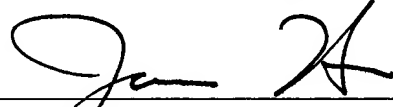
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may

be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No.

4208-4007.

In the event that an extension of time is required, or which may be required in

addition to that requested in a petition for an extension of time, the Commissioner is requested to

grant a petition for that extension of time which is required to make this response timely and is

hereby authorized to charge any fee for such an extension of time or credit any overpayment for

an extension of time to Deposit Account No. 13-4500, Order No. 4208-4007.

Respectfully submitted,
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